

REMARKS/ARGUMENTS

In response to the Office Action mailed September 26, 2006, Applicant amends his application and requests reconsideration. In this Amendment, in order to advance the prosecution, claims 1-3, 7, 12, 13, 15-44, 47, and 48 are cancelled. New claims 49-53 are added. Claims 4-6, 8-11, 14, 45, 46, and 49-53 are now pending.

This Amendment

Many of the claims presented in this Response are combinations of previously pending claims. New claim 49 combines previously pending claims 1-3, 7, and 15 and part of former claim 4. Claim 45 is a combination of examined claims 45 and 46. New claim 50 is derived from former claim 4. New claim 51, a dependent claim, is supported by the disclosure of the patent application as filed from page 15, line 24 through page 16, line 9. New claim 52 is a combination of claims 1-3, 12, 13, and 15. Claim 46 is a combination of examined claims 45 and 46. New claim 53 is supported by the description in the patent application at page 30, lines 9-20.

Non-Prior Art Rejections

Claims 16-22 and 38-48 were rejected as indefinite. According to the Examiner, these claims, in violation of MPEP 2173.05(p), claimed both an apparatus and a method of using the apparatus. Although this rejection is moot in view of the cancellation of the cited claims, the rejection is erroneous and, for that reason, is responded to.

The applicable law was clarified in *IPXL Holdings v. Amazon.com, Inc.*, 77 USPQ2d 1140 (Fed. Cir. 2005). The claim that was the subject of the decision in *IPXL* was a dependent claim depending from a claim directed to an electronic financial transaction system. No question concerning mixture of different types of claims was raised with respect to the independent claim which described, among other things, a "processor causing the display to display on a single screen stored transaction

information; the input mechanism enabling a user to use the displayed transaction information to execute a financial transaction or to enter selections to specify one or more transaction parameters.” No part of that claim was even suggested to be directed to a method. Rather, the independent claim was accepted as being directed to an apparatus. The claim in question, claim 25 in the *IPXL* case, depended from the apparatus claim and further stated

“wherein the predicted transaction information comprises both the transaction type and transaction parameters associated with the transaction type and *the user uses the input means* to either change the predicted transaction information or accept the displayed transaction type and transaction parameters.” (77 USPQ2d at 1145).

In making the rejection, the Examiner cited, in former independent claims 16 and 38, claim language that stated that “said portable safe being transportable by a person between said game-related device and said currency control device.” Apparently the Examiner concluded, clearly erroneously, that the quoted language, which also appears in claims still pending but not rejected as indefinite, constitutes a method step. The Examiner’s position would be tenable if, as part of the claimed subject matter, the claim language were “said portable safe being *transported* by a person”. That language would describe a method step, i.e., actually moving the portable safe between the two recited devices. The fact that the portable safe is transportable is not a method limitation, it is a structural description. The claim language has been clearly misinterpreted and that language is clearly outside the holding of *IPXL*, the only applicable decision by a Court.

Because of similar rejections made, which are discussed below, it is useful to discuss what the cited language of the rejected claims means. In the claims now pending, the language has been slightly changed to refer to the portable safe as “transportable by a single person...”. This description is a structural limitation because it describes a physical characteristic of the portable safe. This language states that the safe is of such size, weight, and bulk that a single person is able to move the

portable safe from one location to another. Accordingly, one would only need to inspect a particular safe to decide whether this claim limitation would be infringed. If the safe could be carried by a single person from one location to another, then the safe would be within the scope of this limitation of the applicable claims. If more than one person would be required, in order to transport the safe between two locations, because of the weight, size, or other characteristic of the portable safe, then the portable safe would be outside this limitation of the applicable claims. The ability to move the safe by a single person is, therefore, a structural description of one feature of the portable safe, clearly not a method description relating to using the safe.

All examined claims, claims 1-48, were rejected as allegedly directed to non-statutory subject material. According to this rejection, which subsequently mentions only claims 15-22 and 38-48, none of which are pending in the present patent application, the claims are non-statutory as being directed to both a process and a machine. Citation is again made to MPEP 2173.05(p). This rejection is erroneous and traversed, although the specific claims cited are no longer pending, for two independent reasons.

First, the foregoing discussion demonstrating that the cited language is not directed to a method, but provides a structural description of the portable safe, is incorporated here, as if repeated at length. The claims do not mix method steps and apparatus limitations.

Second, Applicant agrees that the final paragraph of the cited section of the MPEP alleges that claims falling into two different statutory categories are not patentable as not being directed to a single statutory class of invention. There is no legal citation of any opinion, regulation, or any legal source for this allegation. In fact, there is no such legal basis for this statement, which is mere speculation by the anonymous authors of the MPEP. This position was not endorsed or even discussed by the Court of Appeals for the Federal Circuit in *IPXL*. There is no legal basis for this rejection.

The rejection is clearly erroneous, for the two independent reasons just described, and cannot properly be maintained.

Claims 1-48 were also apparently rejected as non-statutory on the grounds that they allegedly claim a human being. The language of the claims, namely “transportable by a person”, is alleged to state both that “a human being is required as an integral limitation of the independent claims.” The basis of this rejection is the continued misinterpretation of the language of the claims. Moreover, the Examiner provided a totally erroneous citation as allegedly supporting his position. There is no such support for the rejection anywhere in the MPEP or in any decision of which the Applicant’s representative is aware.

As stated in detail above, the cited language only describes the structure of a portable safe within the scope of the invention as being a portable safe that a single person can transport between locations. There is no description in any claim of a safe being transported by a person or any method step of any kind that would invoke the action of a human being.

A reference to a human being in a claim is not an incorporation of that human being into the claimed subject matter any more than reference to any environmental element with respect to a claimed invention makes that environmental element part of the invention that is claimed. Applicant only asks that the Examiner give each word of each claim the precise meaning of the actual word used in the claim. The word “transported” has never appeared in any currently or formerly pending claim in this patent application. The word that appears in the claims in the phrase cited in all of these erroneous rejections is “transportable” which has the ordinary meaning of being able to be carried from one place to another, not actually being carried.

Finally, in this rejection, the Examiner cited *In re Wakefield*, 165 USPQ 636 (CCPA 1970). Allegedly, this opinion shows that including a human being within a claim, a situation not present in the current patent application, makes the claim unpatentable. However, that opinion has no relationship to that issue. Instead, *Wakefield* is concerned with chemical practice issues for a patent application relating

to making a synthetic rubber product. Because of the absence of any connection between the cited opinion and the issue for which it was allegedly cited, Applicant's representative informally inquired of the Examiner whether an error had been made and whether a different opinion was intended to have been cited. The Examiner indicated that he is not familiar with legal opinions or their citations. Accordingly, Applicant respectfully requests that this citation be withdrawn along with the withdrawal of the totally erroneous rejections pursuant to 35 USC 112 and 35 USC 101.

Prior Art Rejections

In view of the combinations of previously pending claims in preparing the independent claims 49 and 50, the rejection of certain examined claims as anticipated by Fukatsu et al. (U.S. Patent 5,804,804, hereinafter Fukatsu) is moot. It would appear, based upon the previously made rejections that new claim 49 might be rejected as obvious over Fukatsu in view of Anderson (Published U.S. Patent Application 2003/0122673) because of the previous rejections of claims 4, 7, and 15. If this rejection is sought to be applied to new claim 49, then the rejection is respectfully traversed.

The currency control system according to claim 49 includes an anomaly detection device that appeared, with some further description, in former claim 4. The further description appears in current claim 4. In previous Office Actions, the Examiner acknowledged that the anomaly detection device was not disclosed in Fukatsu and relied upon Anderson for that claim element. However, that reliance cannot be made in examining claim 49 because Anderson does not suggest adding an anomaly detection device to Fukatsu. In other words, the rejection is erroneous because there is no motivation for modifying Fukatsu with Anderson.

Fukatsu relates to a highly complex robotic system in which a plurality of automatic teller machines are serviced by a robot. The robot supplies cash to the automatic teller machines and retrieves cash and other items from the automatic teller

machines. According to Fukatsu, unlike previously known machines, the robot does not require a track or rails for movement of the robot between the automatic teller machines and a cash receiving/dispensing sorter 132. Instead of using tracks, the robot, in Fukatsu, follows a path established on the floor supporting the robot, the automatic teller machines, and the sorter. The system is automatic and invokes the wireless transmission of instructions to the robot so that it may service the proper automatic teller machine and, when necessary, report to the sorter for interaction. In applying Fukatsu, the Examiner obviously considered the transport cassette 43 of Fukatsu to correspond to the portable safe of the invention.

By contrast with Fukatsu, Anderson is concerned with security and the prevention of theft in the delivery of bank notes to and retrieval of bank notes from automatic teller machines, not by a robot as in Fukatsu, but by persons. See, for example, the description of the specific embodiment beginning in paragraph [0171] of Anderson. In that discussion, Anderson describes the most vulnerable point in the distribution and retrieval of bank notes as the "transport of notes between a delivery vehicle and the ATM site-commonly termed 'crossing the pavement'." Anderson discusses safety of personnel, the extraordinary expense of mechanical locks, and like considerations. Anderson settles on the use of a tag which may be remotely actuated, that activates a dye pack staining and ruining the bank notes in a carrier and that may be the subject of a theft.

In order to use this description of Anderson to modify Fukatsu, there must be some reason for that modification. However, with the entirely robotic system of Fukatsu there is no "crossing the pavement" event and it seems improbable, at best, that the Fukatsu robot would attempt to steal bank notes in the course of transferring those bank notes between automatic teller machines and sorters. According to the Office Action at page 6, the "suggestion/motivation [for the modification of Fukatsu with Anderson] would have been to prevent theft of the valuables inside the portable safe." Again, Applicant respectfully questions how it could be even possible for the robot of Fukatsu to present the possibility of the theft of bank notes from inside

Fukatsu's cassette 43 so that Anderson's security tag would be needed or used. Since there is no rational possibility of theft of money by a robot, the hypothetical modification of Fukatsu with Anderson is legally erroneous and the rejections based upon that hypothetical combination should be withdrawn. Those rejections should not be applied again to new claim 49 nor any of its dependent claims, claims 4-6, 8-11, and 45.

Further comment on the rejections of claims depending from new claim 49 is not necessary. However, in passing, Applicant notes that Anderson never describes an impact or orientation anomaly detector. The Office Action asserted that Anderson describes in its paragraph [0193] a movement detector that amounts to an impact detector. Applicant respectfully disagrees.

The cited paragraph of Anderson mentions a movement detector that triggers a dye pack if a "disturbance of the cassette" is registered when the "in-cassette electronic unit (ICE)" is in a secondary armed state. The Examiner has assumed that the term "disturbance" is equivalent to the term "impact". There is no basis in, nor any further explanation within, Anderson for drawing that conclusion. The conclusion must be based upon hindsight knowledge of the invention. Therefore, no combination of Fukatsu and Anderson, even if that combination were legally proper, could establish *prima facie* obviousness as to claim 4 or claim 8.

Further, the Examiner relied upon Blad et al. (U.S. Patent 6,328,149, hereinafter Blad) as disclosing an orientation anomaly detection device, referring to combinations of elements 44, 46, 50 and 68 and of elements 48, 56, and 58 of Blad. This reliance was misplaced and its renewed assertion would be incorrect.

Applicant respectfully directs the Examiner's attention to Blad at column 8 in the paragraph beginning in line 30. Presumably it is asserted that the electrodes with the reference numbers cited constitute an orientation anomaly detector. However, as pointed out in the cited paragraph of Blad, the electrodes make connections "regardless of directional orientation of coin box 12 within machine 10...". In other words, orientation is not pertinent in the element cited in Blad because the

arrangement of the electrodes overcomes any orientation anomaly, rather than detecting an orientation anomaly. The reliance on Blad was erroneous in the previous Office Action and cannot properly be renewed with respect to orientation anomaly detection of dependent claim 4 or new dependent claim 50. *Prima facie* obviousness cannot be established as to any of those claims based upon any potential combination of Fukatsu, Anderson, and even Blad.

New claim 52 incorporates examined claims 1-3, 12, 13, and 15. Based upon the individual claim rejections of the Office Action, claim 52 might be rejected as unpatentable over Fukatsu in view of Deaville et al. (U.S. Patent 5,907,141, hereinafter Deaville). This rejection is respectfully traversed.

The comments on claims 12-14 at page 9 of the Office Action did not employ the precise language of claims 12 and 13. That language now appears in claim 52. According to the invention as defined by that claim 52, in both attaching the portable safe to *and* removing the portable safe from the game-related device or the currency control device, an authorized operator's card must be inserted into the game-related device or the currency control device. Deaville provides only part of this feature and includes no suggestion for supplying the missing part of this feature.

Deaville describes a vending machine and makes reference to gaming machines, to which a bill validator-stacker unit may be lockably attached. While numerous locking arrangements are described, including mechanical locks, the Deaville apparatus includes an electronic lock as well. The validator unit of Deaville includes an entry for receiving bills, such as bank notes, in conjunction with the operation of the machine to which the validator is attached. The validator is also constructed to receive and recognize security coupons that are preferably the same size and shape as the bank notes that are accepted for purchase or operation of the machine to which the validator is attached. According to further disclosure appearing in the paragraph beginning in column 4, line 13 of Deaville, "a security coupon... serves as a physical key to permit the front panel [of the vending machine] to be unlocked and to permit removal of an "a currency cassette 200".

No security coupon of Deaville, analogized by the Examiner to the operator's card of the invention as defined by claim 52, is employed to attach the currency cassette 200 to the bill validator. Therefore, as tacitly acknowledged by the absence of a direct quotation of the claim language at page 9 of the Office Action, Deaville fails to supply all of the limitations of examined claim 12 and, therefore, of new claim 52. Accordingly *prima facie* obviousness has not been established with respect to that claim.

Moreover, there is no suggestion in Deaville for requiring the use of an authorized operator's card or corresponding security coupon to attach a cassette to a vending machine or other apparatus. As described in column 8, lines 6-22 of Deaville, when an authorized security coupon is inserted in the bill validator and recognized as authorized, the coupon is captured within the bill validator from which the cassette 200 may be detached. When the security coupon is invalid, the security coupon is returned to the person inserting the security coupon. The captured authorized security coupon is evidence of authority of the person who removes the cassette 200 when that cassette is opened for removal or insertion of further currency. This operation is totally contrary to the concept of requiring a security coupon to attach the bill validator, analogized to the portable safe of the invention, to the vending machine.

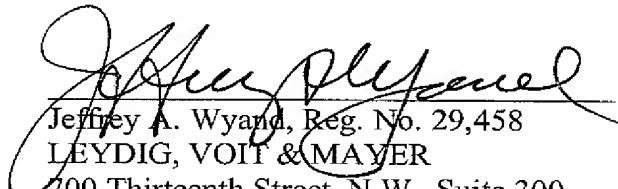
In the invention, the portable safe is loaded with currency before attachment to a game-related device. That currency is dispensed by the game-related device. By requiring the use of an authorized operator's card to make the attachment, tracking of the portable safe, i.e., bill validator, is improved and made complete. No such tracking is provided by Deaville, perhaps because Deaville's validator is attached in an empty state to a vending machine. Moreover, carrying the alleged analogy further, if, in the invention, the operator's card were captured at the time of attachment of a portable safe to game-related device, there would be a need for continually supplying operator's cards, increasing opportunity for breaching the security provided by those cards. Deaville simply fails to suggest a modification that could possibly meet the

limitation of examined claim 12 and corresponding limitation of new claim 52. Therefore, it would be improper to apply against new claim 52 and its dependent claims 14 and 46 the same rejection made in examining formerly pending claims. *Prima facie* obviousness of claim 52 and its dependent claims 14 and 46 cannot be established by previously applied combination of publications.

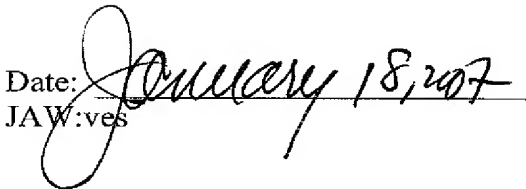
Further comment with respect to claims 14 and 46 is neither necessary nor supplied.

Upon consideration of the claims newly submitted, those claims and their dependent claims should be allowed.

Respectfully submitted,


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